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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,436	10/13/2001	Hans Westmijze	ACD2665 US	2901

7590 06/25/2002
Richard P Fennelly
Akzo Nobel Inc
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,436

Examiner

Judy M. Reddick

Applicant(s)

WESTIMIJZE ET AL

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/11/01;01/30/02;04/15/02.
- 2a) ☒ This action is FINAL.
- 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

1. **The information disclosure statement filed 10/11/01 has been considered and placed in the application file.**

Claim Objections

2. **Claim 6 is objected to because of the following informalities: In claim 6, line 4, it is suggested that applicant adopt the following language: "wherein the total weight" or "with the proviso that the total weight" in lieu of "while the total weight". Appropriate correction is required.**

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 10, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
 - A) **The recited "viscosity of 10-300 mPa.s" per claim 10 constitutes indefinite subject matter as per the conditions under which such was obtained is not readily ascertainable.**
 - B) **The recited "A polymerization process comprising the polymerization of a monomer in the presence of an emulsion according to any one of claims 1-5" engenders awkwardly expressed claim language. The following language is suggested: "A polymerization process comprising polymerizing a monomer in the presence of an emulsion according to any one of claims 1-5".**

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- C) The recited "comprising one or more peroxides" per claim 13 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "peroxide".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 492,712 in combination with International WO 98/18835, Lundin et al(U.S. 4,499,250) or Lundin et al(U.S. 4,547,481) and Satomi et al(U.S. 4,734,135) as per reasons clearly set forth in the previous Office Action per paper no. 7, 12/17/01, paragraph no. 8. As to the newly added dependent claims, the limitations are either taught by the prior art combination supra, suggested by the prior art combination supra or would have been obvious to the skilled artisan and with a reasonable expectation of success. There is absolutely nothing viable on this record diffusing this issue.

Response to Arguments

9. Applicant's arguments filed 04/15/02 have been fully considered but they are not persuasive.

Relative to the 112, 2nd paragraph issue—It is urged and maintained that the conditions under which the viscosity limitation per claim 10 was obtained is not readily ascertainable. Although Counsel has provided several patents that use the claimed viscosity terminology, Counsel is herein apprised that each application stands on its own, i.e., is treated on its own merits.

Relative to the rejection under 35 USC 103—It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over the prior art combination supra as per reason clearly set forth in the Grounds of Rejection of record.

The crux of Counsels arguments appears to hinge on each of the secondary references adding a multiplicity of components to the already existing compositional formulation of the primary reference EP'712 and, to this end, and with all due respect to Counsel's opinion, the secondary prior art simply provide

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ample motivation to employ an ethoxylated fatty alcohol, as claimed, in the compositional formulation of EP'712 and with a reasonable expectation of obtaining its cumulative, additive effect. Criticality for such, not having been demonstrated on this record. Moreover, even if this were not the case and Counsel was right, the claims don't preclude additional components since the term "comprising" is an open door invite for additional ingredients.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
June 21, 2002